

REMARKS

Applicant appreciates the Examiner's thorough consideration provided the present application. Claims 1-10, 12-15, 17 and 18 are now present in the application. Claims 1, 10 and 12 have been amended. Claims 11 and 19-21 have been cancelled. Claims 1, 10 and 12 are independent. Reconsideration of this application, as amended, is respectfully requested.

Interview With The Examiner

An interview was conducted with the Examiner in charge of the above-identified application on May 24, 2006. Applicant greatly appreciates the courtesy shown by the Examiner during the interview.

In the interview with the Examiner, Applicant's representative presented the argument with regard to the rejection under 35 U.S.C. § 102(e). Specifically, it was argued that Humpleman fails to teach a non-IP based data processing protocol layer and an interface between the non-IP based data processing protocol layer and the IP based network as recited in claims 1, 10 and 12. The Examiner, however, took the position that although Humpleman does not explicitly disclose a non-IP based data processing protocol layer and an interface between the non-IP based data processing protocol layer and the IP based network, since Humpleman discloses the home network can be a non-IP protocol, Humpleman's Internet proxy inherently will have to be such that it converts between IP protocol and non-IP protocol. No agreement has been reached during the interview.

Claim Rejections Under 35 U.S.C. §§ 102 & 103

Claims 1-10, 12-15 and 17-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Humpleman et al., U.S. Patent No. 6,198,479 (hereinafter referred to as “Humpleman”). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Humpleman in view of Gupta et al., U.S. Patent No. 5,864,542 (hereinafter referred to as “Gupta”). These rejections are respectfully traversed.

Complete discussions of the Examiner’s rejections are set forth in the Office Action, and are not being repeated here.

In light of the foregoing amendments to the claims, Applicant respectfully submits that this rejection has been obviated and/or rendered moot. Without conceding to the propriety of the Examiner’s rejection, but merely to timely advance the prosecution of the application, as the Examiner will note, independent claims 1, 10 and 12 have been amended.

Independent claim 1 now recites a combination of elements including “a second server connected to the non-IP based network and an IP based network (the Internet), the second server receiving an Internet service request from the IP based network and selecting one of the first server and the second server to provide an Internet service based upon the Internet service request, the second server including: a non-IP based data processing protocol layer connected to the non-IP based network, an IP-to-non-IP interface connected to non-IP based data processing protocol layer and the IP based network (the Internet), and an application program as installed” and “the IP-to-non-IP interface allows communication of data between the IP based network and the non-IP based data processing protocol layer, the non-IP based data processing protocol layer communicating with the first server via the non-IP based network, so that the Internet service

from the first server is provided from the non-IP based network to the Internet via the second server when the Internet service request corresponds to the first server.”

Independent claim 10 now recites a combination of steps including “a step in which a second server, connected to a non-IP based network and an IP based network (the Internet), receives an Internet service request from an IP based network (the Internet) and selects one of a first server in the non-IP based network and the second server to provide an Internet service based upon the Internet service request”; “when the Internet service request corresponds to the first server, a step in which the first server in the non-IP based network receives the Internet service request from the IP based network (the Internet) via an interface of the second server and a non-IP based data processing protocol layer of the second server, the interface converting the Internet service request from the IP based network to the non-IP based data processing protocol layer, the non-IP based data processing protocol layer transmitting the converted Internet service request to the first server via the non-IP based network; and a step in which the first server in the non-IP based network provides the Internet service via the second server”; and “when the Internet service request corresponds to the second server, a step in which the second server provides the Internet service to the Internet therefrom”.

Independent claim 12 now recites a combination of elements including “a first appliance for controlling communication of the non-IP based network with an IP based network (the Internet), the first appliance including an IP-to-non-IP interface and a non-IP based data processing protocol layer, the IP-to-non-IP interface being connected to the non-IP based data processing protocol layer and the IP based network, the non-IP based data processing protocol layer being connected to the non-IP based network, the IP-to-non-IP interface allowing

communication of data between the IP based network and the non-IP based data processing protocol layer of the first appliance” and “a second appliance connected and communicating with the non-IP based data processing protocol layer of the first appliance via the non-IP based network, the first appliance receiving an Internet service request from the IP based network and selecting one of the first appliance and the second appliance to provide an Internet service based upon the Internet service request, when the Internet service request corresponds to the second appliance, the first appliance sending the Internet service request to the second appliance such that the second appliance provides the Internet service to a third appliance connected with the Internet via the first appliance”.

Support for the amendments to claims 1, 10 and 12 can be found on the paragraphs beginning on page 5, line 7 and on page 6, line 22 of the specification. Applicant respectfully submits that the above combinations of elements and steps as set forth in claims 1, 10 and 12 are not disclosed or suggested by the references relied on by the Examiner.

Humbleman in FIG. 14 merely discloses an *IP-based* home network 1110 including an HTTP/IP based data bus 114. Humbleman further discloses that communication on the home network is provided through the use of the TCP/IP standard network protocols and that each home device is associated with a unique IP address (see col. 10, lines 45-52).

Although Humbleman discloses that other communication protocols such as Function Control Protocol (FCP) could be used to provide communication for a home network 100 in FIG. 1, Humbleman fails to teach how the home devices in such a non-IP-based (FCP) home network 100 is applied to the structure shown in FIG. 14 of Humbleman, which is an *IP-based network*. Although the Examiner during the interview took the position that since Humbleman discloses

the home network can be a non-IP protocol, Humpleman's proxy server inherently will have to be such that it converts between IP protocol and non-IP protocol, Applicant respectfully disagree.

First of all, the embodiment shown in FIG. 14 of Humpleman clearly shows that the home network 100 is an HTTP/IP network, *i.e.*, an IP based network. Humpleman in col. 20, lines 43-50 also discloses:

Because the *home network is Internet protocol compatible*, connecting the home network to the Internet can provide the advantage of being able to control home devices from outside the home. Therefore, in certain embodiments of the invention, a connection is provided which allows the home network to interface with the Internet. *FIG. 14 depicts a home network 1100 connected to the Internet 1102 in accordance with the present invention...* (Emphasis added.)

In other words, the advantage of being able to control home devices from outside the home can only be provided when the home network is Internet protocol compatible. If the home network is not Internet protocol compatible, this advantage will not be provided in the embodiment of FIG. 14. Therefore, one skilled in the art would not replace the HTTP/IP home network 1100 with the non-IP based network such as the Function Control Protocol (FCP).

In addition, Humpleman in col. 20, lines 53-58 further discloses:

As depicted in FIG. 14, in certain embodiments an Internet proxy 1104 is used to provide an interface between the home network 1100 and the Internet 1102. By providing an interface between the home network 1100 and the Internet 1102 a user can remotely control home devices connected to the home network 1100...

Since FIG. 14 of Humpleman clearly labels the home network 1100 as the HTTP/IP network, it further clarifies that the home network 1100 in the embodiment shown in Fig. 14 of Humpleman must be an IP based network in order to provide the advantage of remotely controlling the home

devices. Humpleman also discloses that by employing the Internet Protocol standard, the home devices can communicate with each other without having to know specific details about the other communication layers (see col. 4, lines 54-62). Therefore, according to the advantage of the IP based home network as described in Humpleman, one skilled in the art would not replace the HTTP/IP home network 1100 in FIG. 14 of Humpleman with a non-IP based network because, when using the non-IP based network, he/she has to deal with the problems of understanding specific details about the other communication layers of the other home devices.

Second, under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Cont’l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). There can be no speculation or only possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. The mere fact that something *may* result from a given set of circumstances is not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

In this case, the non-IP based data processing protocol layer and the IP-to-non-IP interface between the non-IP based data processing protocol layer and the IP based network as recited in claims 1, 10 and 12 are *not* necessarily present in Humpleman. In particular, even if

the Function Control Protocol were used to replace the HTTP/IP network, assuming *arguendo*, it is not necessarily that the Internet proxy 1104 has to include the non-IP based data processing protocol layer and the IP-to-non-IP interface between the non-IP based data processing protocol layer and the IP based network as recited in claims 1, 10 and 12. Other arrangement and structures may be able to overcome the compatible problems. Since the Examiner bears the initial burden of presenting a *prima facie* case of unpatentability, if the Examiner persists in his position of inherency, Applicant respectfully requests that the Examiner provide the evidence that the non-IP based data processing protocol layer and the IP-to-non-IP interface as recited in claims 1, 10 and 12 are necessarily present in Humpleman's Internet proxy 1104.

In the alternative, Humpleman's Internet proxy 1104 is simply used to provide an interface between the home network 1100 and the Internet 1102 so that the user can remotely control the home devices such as a DVCR 110, for example, programming the DVCR to record a particular event (see col. 20, lines 53-62). Humpleman's Internet proxy 1104 (referred to by the Examiner as the second server of claims 1 and 10, and the first appliance of claim 12) *itself* cannot provide any Internet service based on the Internet service request. Unlike Humpleman, the second server/first appliance as embodied in the present invention provides an Internet Web service to the Internet (see page 7, line 24-25). Therefore, Humpleman fails to teach "a second server connected to the non-IP based network and an IP based network (the Internet), the second server receiving an Internet service request from the IP based network and selecting one of the first server and the second server to provide an Internet service based upon the Internet service request" as recited in amended claim 1, "a step in which a second server, connected to a non-IP based network and an IP based network (the Internet), receives an Internet service request from

an IP based network (the Internet) and selects one of a first server in the non-IP based network and the second server to provide an Internet service based upon the Internet service request" and "when the Internet service request corresponds to the second server, a step in which the second server provides the Internet service to the Internet therefrom" as recited in amended claim 10, and "the first appliance receiving an Internet service request from the IP based network and selecting one of the first appliance and the second appliance to provide an Internet service based upon the Internet service request" as recited in amended claim 12.

In the alternative, Humpleman's home devices (referred to by the Examiner as the first server of claims 1 and 10, and the second appliance of claim 12) cannot provide any service to the Internet via the Internet proxy 1104, either. As mentioned, Humpleman simply discloses that the user can program the DVCR to record a particular event. In other words, it is merely a *unilateral control*. Humpleman nowhere discloses that the DVCR provides any Internet service such as providing the recorded event to the Internet. Therefore, Humpleman fails to teach "the Internet service from the first server is provided from the non-IP based network to the Internet via the second server when the Internet service request corresponds to the first server" as recited in amended claim 1, "when the Internet service request corresponds to the first server,... a step in which the first server in the non-IP based network provides the Internet service via the second server" as recited in amended claim 10, and "when the Internet service request corresponds to the second appliance, the first appliance sending the Internet service request to the second appliance such that the second appliance provides the Internet service to a third appliance connected with the Internet via the first appliance" as recited in amended claim 12.

With regard to the Examiner's reliance on Gupta, this reference has only been relied on for its teachings related to dependent claim 11. This reference also fails to disclose the above combinations of elements and steps as set forth in independent claims 1, 10 and 12. Accordingly, Gupta fails to cure the deficiencies of Humpleman.

Accordingly, neither Humpleman nor Gupta individually or in combination teaches or suggests at least the above-noted features of independent claims 1, 10 and 12. Therefore, Applicant respectfully submits that independent claims 1, 10 and 12 and their dependent claims (at least due to their dependency) clearly define over the teachings of Humpleman and Gupta. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102 and 103 are respectfully requested.

CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application and the required fee of \$120.00 is attached herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: June 23, 2006

Respectfully submitted,

By Esther Chong
Esther H. Chong
Registration No.: 40,953
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant